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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/053,192

01/15/2002

Heinrich Bachmann

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(C38435/128985)

4078

7590

05/20/2003

Stephen M. Haracz, Esq.  
Bryan Cave, LLP  
245 Park Avenue  
New York, NY 10167-0034

EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,192

Applicant(s)

BACHMANN ET AL.

Examiner

Yong Pak

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-36 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

Art Unit: 1652

### **DETAILED ACTION**

This application is a CIP of 09/504,393.

The instant application as originally filed contains two claims 27. In accordance with 37 CFR § 1.126, starting at the second occurrence of claims 27, claims have been renumbered 28-36 with dependencies changed accordingly. The new numbers have been used hereinafter.

Claims 1-36 are pending.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 33 drawn to dioxygenase and a method of use thereof, classified in class 435, subclass 25.
- II. Claims 6-15, 19-32, and 34-36, drawn to DNA encoding dioxygenase and vector encoding said DNA, host cell comprising thereof, antisense RNA and primer, probe and test kit for amplifying/detection of said DNA, classified in class 435, subclass 6.
- III. Claims 16-17, drawn to antibody against dioxygenase and method of using antibody, classified in class, 530 subclass 387.9.
- IV. Claim 18, drawn to a method of producing Vitamin A, classified in class 568, subclass 824.

The inventions are distinct, each from the other because of the following reasons:

The protein of Invention I is related to the nucleic acids of Invention II by virtue of encoding the same. Although the DNA molecule and protein are related since the DNA encodes the claimed protein, they are distinct inventions. The two are physically and functionally distinct chemical entities. Also, the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from a natural source. Furthermore, the DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assay.

The methods of Invention II and the polypeptide of Invention I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed maybe isolated form a natural source.

The enzyme of Invention I is related to the antibodies of Invention III by virtue of being cognate antigen, necessary for the production of antibodies. Although the polypeptide and antibody are related due to necessary strike complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities. The structure of antibody is unpredictable from the structure of the protein. Also because the enzyme can be used in another and materially different process from the use for production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the cognate receptor of the protein (as

Art. Unit: 1652

the protein is itself a ligand), or in assays for the identification of agonists or antagonists of the receptor protein.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, Vitamin A can be isolated from a natural source. Furthermore, dioxygenase can be used in production of antibodies.

The DNA of Invention II is distinct from the antibody of Invention III. DNA and antibody are physically and functionally distinct chemical entities. Also the methods of Inventions II-IV are patentably distinct as employing different products. Invention II uses DNA encoding dioxygenase, Invention III uses an antibody and Invention IV uses dioxygenase.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art. Unit: 1652

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak  
Patent Examiner

May 16, 2003

  
PONNATHAPU ACHUTAMURTHY  
SUPERVISOR OF EXAMINERS  
703-308-3804